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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/791,155	03/01/2004	Amon Lavie	02-134-D	3822
7590 06/20/2007 Jason J. Derry McDonnell Boehnen Hulbert & Berghoff LLP 300 S. Wacker Drive Chicago, IL 60606			EXAMINER YAO, LEI	
			ART UNIT 1642	PAPER NUMBER
			MAIL DATE 06/20/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/791,155

Applicant(s)

LAVIE ET AL.

Examiner

Lei Yao, Ph.D.

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1642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 3/37/2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,6-8 and 69 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,6-8 and 69 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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Response to Argument and Amendment

The Amendment filed on 3/27/2007 in response to the previous Non-Final Office Action (12/27/2006) is acknowledged and has been entered.

Claims 2-5, 9-68 and 70-169 have been cancelled. Claims 1, 6-8, and 69 are pending and under consideration.

Rejections Withdrawn

1. The rejection of 1, 6-8, and 69 under 35 USC § 101 because the claimed invention is not supported by either a specific, substantial, and credibly asserted utility is withdrawn in view of applicant's argument.
2. The rejection of claims 1, 6-8 and 69 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is withdrawn in view of amendment to the claims.

Response to Arguments

Rejection under 35 USC § 112, first paragraph

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 6, 8, and 69 remain rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement.

The response filed 3/27/2007 has been carefully considered but is deemed not to be persuasive. Applicant argues that Zhu et al., teach that both nuclear and cytosolic dCK can phosphorylate nucleoside analog AraC (figure 2 and 3) and nucleoside analogs phosphorylated by either nuclear or cytosolic dCK, not mitochondrial dCK (figure 3). In response to this argument, the Office agrees with applicant that the nucleoside analog AraC is phosphorylated by both nuclear and cytosolic dCK, which are transfected and

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expressed inside of the cells. However, the claimed invention is drawn to an antibody-conjugate dCK used for treating leukemia blast cells by the mechanism of phosphorylation of nucleoside analogs incorporated into DNA and causing cell death. As such, the antibody conjugate as treatment agent is required to be penetrated into nucleus in order to perform the function and be used by one skilled in the art for treating a tumor. The specification neither provides a teaching showing the antibody-conjugate works inside of the nucleus of a cell, nor a direction or guideline to show how the antibody conjugate phosphorylate the nucleoside, such as AraC, located inside of the nucleus of the cell. The teaching of Zhu et al., does not resolve the problem or suggest the invention enabled because the transfected dCK-GFP is originally expressed and stayed inside of the nucleus of the cells. In addition, examples and figures such as figures 6-9, do not show the significant difference in the cells treated with Ara C alone or Ara C plus the conjugate. Thus, Applicant's argument has not been found persuasive, and the rejection is maintained.

In addition, based on the applicant's argument, replication of DNA in mitochondria seems not be concerned in this application, therefore, the Office will not further discuss this issue.

Conclusion

No claim is allowed.

THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lei Yao, Ph.D. whose telephone number is 571-272-3112. The examiner can normally be reached on 8am-6.00pm Monday-Thursday.


Any inquiry of a general nature, matching or file papers or relating to the status of this application or proceeding should be directed to Kim Downing for Art Unit 1642 whose telephone number is 571-272-0521

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shanon Foley can be reached on 571-272-0898. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Lei Yao,
Examiner
Art Unit 1642

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SUPERVISORY PATENT EXAMINER
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